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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,395	05/10/2005	Mark A Weber	WEBER, M.A 1 PCT	2857
25889	7590	11/27/2006	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			PRITCHETT, JOSHUA L	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/534,395	WEBER, MARK A
Examiner	Art Unit	
Joshua L. Pritchett	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 10 May 2005.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-15 is/are rejected.

7)  Claim(s) 1-15 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 10 May 2005 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/05.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_.

## **DETAILED ACTION**

This action is in response to Preliminary Amendment filed May 10, 2005. Claims 3-15 have been amended as requested by the applicant.

### ***Specification***

The disclosure is objected to because of the following informalities: the specification contains no reference to the equalization length as claimed in claims 6 and 7.

Appropriate correction is required.

### ***Information Disclosure Statement***

The information disclosure statement filed May 10, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The foreign patent and the non-patent literature document were not included and therefore have not been considered. The US patent references have been considered as shown in the PTO-1449.

### ***Claim Objections***

Claims 1-15 are objected to because of the following informalities:

Regarding claim 1, claim 1 states “the latter” it is not entirely clear which element the applicant is intending to refer to as “the latter.” Examiner is interpreting “the latter” to be the microscope body.

Regarding claim 15, claim 15 states, “in other words focusing.” The claim is unclear whether applicant intends to claim focusing or merely adjustment of the distance between the lens and the internal surface of the cylinder which could be accomplished by moving the cylinder into and out of the cylinder which would adjust the distance between the bottom surface of the cylinder and the lens.

The remaining claims depend from claim 1 and inherit the deficiencies thereof.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8-10 and 12-15 rejected under 35 U.S.C. 102(b) as being anticipated by West (US 4,963,018).

Regarding claim 1, West discloses method in computer-controlled confocal microscopy, for producing three-dimensional surface images of the internal surfaces of cylinders in engine blocks (col. 1 lines 60-65), by using a confocal microscope having a microscope body (Fig. 1), a tube (11) attached to the microscope body and having a lens (46), which is preceded by a deflection optical system (41 or 44) having a horizontal translator (col. 3 line 62 –col. 4 line 10).

Regarding claim 2, West discloses a deflection optical system located ahead of the lens (Fig. 2).

Regarding claim 3, West discloses the deflection optical system consists of a reflection prism (41).

Regarding claim 4, West discloses the deflection optical system consists of a surface mirror (44).

Regarding claim 5, West discloses the deflection optical system deflects the beam by less than 90-degrees (44; Fig. 2).

Regarding claim 8, West discloses the lens can be moved by means of a piezo setting element (col. 6 lines 53-55).

Regarding claim 9, West discloses the lens can be moved by means of a stepper motor (15).

Regarding claim 10, West discloses a device for attaching and adjusting the computer-controlled confocal microscope to be moved into cylinders of engine blocks, to measure the internal surfaces of the cylinders (col. 3 lines 45-55).

Regarding claim 12, West discloses the microscope can be moved into the cylinder by means of a linear guide (col. 3 lines 34-40).

Regarding claim 13, West discloses the microscope is adjustable and can be fixed in place with regard to the insertion depth, by means of the linear guide (col. 3 lines 34-60).

Regarding claim 14, West discloses the attachment device of the adjustment device allows a rotation about the cylinder axis (col. 2 lines 20-25).

Regarding claim 15, West discloses the attachment allows an adjustment of the distance between the lens an the internal surface of the cylinder, in other words focusing (col. 3 line 62 – col. 4 line 10).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over West (US 4,963,018).

Regarding claims 6 and 7, West teaches the invention as claimed but lacks reference to the equalization length. The current specification fails to mention equalization length. The examiner therefore is interpreting the equalization length to be similar to that of the focal length. West teaches the focus of the microscope is adjustable (col. 3 line 62 – col. 4 line 10). Therefore

it would be within the skill of one of ordinary skill in the art at the time the invention was made to have the focal length be a wide range of distances including 45mm and shorter distances. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the West reference have the claimed equalization length as suggested by West for the purpose of viewing the wall of the cylinder at different distances to obtain an in-focus image of the cylinder wall.

Regarding claim 11, West teaches the invention as claimed but lacks reference to a clamp or screw attachment. West suggests the use of a positioner (13) on the microscope. The tabs 13 as seen in Fig. 2 act very similar to a clamp because the tabs act to hold the microscope in place relative to the cylinder during inspection of the cylinder wall. The examiner interprets the tabs as taught by West to be an obvious equivalent of a clamp. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the West invention include a clamp for the purpose of more securely holding the microscope in place relative to the cylinder being inspected.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joshua L Pritchett  
Examiner  
Art Unit 2872